UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/501,217	02/10/00	MURAD H	2267-017

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HM22/0522

EXAMINER	
CHANNAVAJJALA, L	

ART UNIT	PAPER NUMBER
1615	2

DATE MAILED: 05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/501,217	MURAD, HOWARD	
	Examiner	Art Unit	
	Lakshmi S. Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-27 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Receipt of Information Disclosure Statement dated 2-10-00 is acknowledged.

Claim Objections

Claims 3, 5-7, 16, 17 and 21 objected to because of the following informalities:

Claims 3, 5-7, 16 and 21 recite improper markush which include specific plant extracts, inorganic metals, proteins extracts, specific proteins, specific vitamins and classes of compounds. Appropriate correction is required.

Claim 7 recites GLA-3, which is improper. It is requested that a full form is recited.

Claim 17 recites the expression "to prevent or facilitate repair of damaged skin" . It is suggested that the expression be changed to "prevent damage of skin or facilitate the repair of skin", in order to be more appropriate.

Claim Rejections - 35 USC § 112

Claims 1, 9, 11-13, 19, 21 and 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and 24 recites "patient having skin". It is unclear to the examiner if the claims exclude a particular group of patients.

Claim 9 recites "red veterinary petrolatum". There is no definition or description in the instant specification as to what "red veterinary petrolatum" is. It is unclear if "red veterinary petrolatum" is the same as "petrolatum" commonly used in cosmetic compositions.

Claims 11 and 13 recite the amounts of the specific components, "if present". It is vague and indefinite from the expression, if the components are present or not.

It appears from claims 12 and 13 that applicants intend to limit the claims to plant various "extracts" recite some components as extracts such as i.e., wild yam extract, rosemary extract, soy, ginger etc. However, the claims are indefinite because they recite only some components as extracts and others as such.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/501,218. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims directed to a method of managing one or more dermatological conditions utilizes the same a composition that reads on the instant claimed composition. Accordingly, the instant composition is over the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by USPN 5,891,440 to Lansky.

Lansky discloses an ointment composition comprising pomegranate extract, other plant and herbal extracts. The composition comprises cocoa butter, which read on the instant moisturizing agent. Lansky discloses oral and topical administration. See abtract, Col. 3, lines 12-27; col. 6, lines 37-68; col. 8, lines 43-52. Absent showing any evidence on the contrary, the pomegranate extract of Lansky is capable of neutralizing free radicals and the cocoa butter of the composition facilitates hydration of skin.

Claims 24-27 are rejected under 35 U.S.C. 102(a) as being anticipated by USPN 5,985,300 to Crotty et al (Crotty).

Crotty discloses skin care compositions containing fruit extracts, zinc salts and other components such as ceramides, vitamins, mono- or polyhydroxy acids etc. See abstract, col. 4,

lines 15-22 and col. 5, lines 12-40. Absent showing evidence on the contrary, the fruit extracts of Crotty have the capability to neutralize free radicals, as claimed. Accordingly, Crotty anticipates the instant claims 24-27.

Claims 1-3, 5, 6, 10, 11 and 14-27 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,030,622 to Shehadeh.

Shehadeh discloses a herbal extract composition containing pomegranate extract, minerals such as zinc, magnesium, copper, proteins, vitamins, other plant extracts such as echinacea for immunity boosting (see col. 3-5). Vitamin E of Shehadeh reads on the moisturizing agent and proteins read on hydrophilic moisturizing agent. Shehadeh teaches oral as well as topical administration and accordingly, their composition reads on the instant dermatological agent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crotty et al (Crotty) in view of Lansky OR Crotty and Lansky in view of USPN 6,030,620 to Pillai.

Crotty discloses skin treatment compositions (i.e., dermatological agent) containing fruit extracts, plant extracts, phytoestrogens, herbal extracts, alpha- and beta-hydroxycarbolic acids, antiinflammatories, vitamins, flavonoids etc., all of which read on the claimed moisturizers,

sunscreens, transition metals, anti-inflammatory agents, immunity boosting agents, ceramides, zinc salts etc. See col. 2, lines 40 through col. 5, lines 43, for individual vitamins, hydroxycaroboxylic acids, plant or herbal extracts and other components. Crotty fails to teach pomegranate extract in their composition. However, Crotty suggests adding phytroestrogens in their skin care compositions as an active ingredient. See table in col. 3.

Lansky described above, teaches pomegranate extracts in topical composition for supplementing phytoestrogens. Lansky teaches extracting pomegranate seeds and admixing with other herbal extracts such as licorice (col. 4) and using as a skin cream (abstract, col. 2, lines 3-36) Further, Lansky recognizes that pomegranate seed extracts have been used for treating oily skin (col. 2, lines 20-23). Lansky teaches topical as well as oral administration of phytoestrogens.

Accordingly, it would have been obvious for one of an ordinary skill in the art to add phytoestrogen containing pomegranate extracts of Lansky in the skin care compositions of Crotty, with an expectation to improve the condition of skin, because Lansky discloses that pomegranate extracts (containing phytoestrogens) are known for treating oily skin conditions and Crotty teaches plant extracts, phytoestrogen extracts, flavonoids extracts as free radical inhibitors and antioxidants.

Alternatively, Pillai teaches phytoestrogens obtained from chick pea extracts can be used to treat wrinkled, dry, lined, rough, flaky, aged and/or UV-damaged skin conditions to improve the appearance and the feel thereof as well as for application for healthy skin to prevent or retard deterioration thereof. Pillai does not teach Pomegranate extracts. However, it would have been obvious for a skilled artisan from the teachings of Pillai and Lansky, that irrespective of the plant origin, phytoestrogens are capable of improving the condition of a healthy as well as afflicted

skin. Therefore, it would have been obnvious to incorporate the pomegranate extract of Lansky in the skin composition of Crotty, with an expectation to successfully treat the various skin conditions (aging, wrinkles, fry skin etc.,) and also improve the appearance of healthy skin.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala (lakshmi.channavajjala@uspto.gov) whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM - 4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7921/7924 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Lakshmi Channavajjala
May 18, 2001

IRMAN K. PAGE
SORY PATENT EXAMINER
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